



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:
Siavash Fallahi *et al.*
Appl. No. 10/028,781
Filed: December 28, 2001
For: **IP Telephone System**

Confirmation No. 6416
Art Unit: 2817
Examiner: *To be Assigned*
Atty. Docket: 1875.1270001

Petition to Make Special Under 37 C.F.R. § 1.102(d)

**Attention: Group 2800
Special Program Examiner**

Commissioner for Patents
Washington, D.C. 20231

Sir:

This is a petition to the Assistant Commissioner to make the above-identified patent application special. The grounds and conditions for granting this application special status are found in M.P.E.P. § 708.02 VIII entitled "Special Examining Procedure for Certain New Applications - Accelerated Examination." The Petition Fee required pursuant to 37 C.F.R. § 1.17 is enclosed.

As provided for in M.P.E.P. § 708.02 VIII, Applicants agree to the special examining procedure detailed therein. This Petition is divided into the following sections:

- I. A statement that the claims are directed to a single invention.
- II. A description of a pre-examination search performed in connection with this application.
- III. A list of the documents uncovered by the pre-examination search and deemed most closely related to the subject matter encompassed by the claims.

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- IV. A detailed discussion of the documents, pointing out, with the particularity required by 37 C.F.R. §§ 1.111(b) and 1.111(c), how the claimed subject matter is distinguishable over the documents.
- V. Petition Fee.
- VI. Conclusion.

I. The Claims Are Directed To a Single Invention

Claims 1-33 are pending in the application, and it is believed that these claims are directed to a single invention.

II. Scope and Results of a Pre-examination Search

The subject matter of the above-identified application relates to a communications device (e.g. Internet Protocol communication device). Applicants have not received an Office Action concerning the examination of the present application. A search was conducted by the International Searching Authority of the European Patent Office (EPO) in a counterpart international application filed under the Patent Cooperation Treaty (PCT), Intl. and given Appl. No. PCT/US01/50437. The claims in the PCT application are substantially identical to the pending claims in the present application. A copy of the International Search Report (PCT Form 210) is attached to this Petition. The search was conducted in the following field(s): IPC 7 H04M.(See, section B of the International Search Report) As stated in M.P.E.P. § 708.02: VIII (C), a search made by a foreign patent office satisfies the pre-examination search requirement. Therefore, the Applicants assert that this search

satisfies the pre-examination search requirement because it was performed by the European Patent Office in support of a corresponding PCT application with identical claims.

III. List of Documents Uncovered by the Pre-examination Search

The documents identified in the International Search Report are listed below, and copies of these documents are submitted herewith. All of these documents were also submitted in an Information Disclosure Statement for the present application that was filed on July 31, 2002. These documents are deemed most closely related to the subject matter encompassed by the claims that are known by the Applicants.

Applicants do not waive any rights to appropriate action to establish patentability over any of the listed documents should they be applied as references against the claims of the present application.

The International Search Report listed the following documents (References 1 to 4):

a) Foreign Patent Documents

1. WO 98/37665
2. WO 00/67452

b) Other Information and Publications

3. Hafer, R., "Designing Telephone-Interface Circuitry With Solid-State Relays," *Electronic Design*, 38:91-93 and 95-96, Penton Publishing, (December 1990)
4. Foo, S., *et al.*, "A Telephone Adapter For Internet Telephone Systems," *Microprocessors and Microsystems*, 21:213-221, IPC Business Press Ltd., (December 1997)

IV. Detailed Discussion of the Documents

The documents uncovered by the pre-examination search, and most closely related to the subject matter of the claims 1-33 are discussed below.

Reference 1: WO 98/37665

Reference 1 appears to be related to an Internet switch box that connects between a telephone set and a public switched telephone network (PSTN) line, where the PSTN can be used for telephone conversations and for connection to an Internet service provider (ISP). The Internet switch box contains hardware and software for establishing a connection to an ISP and for Internet telephony. The switch box is capable switching users engaged in telephone conversation over the PSTN to Internet telephony that is conducted via the ISP.
(Abstract)

However, reference 1 does not teach or suggest a communications device as recited in Applicants' claims. Considering claim 1, for example, Reference 1 does not teach or suggest a relay that is disposed on a substrate, and capable of being closed when zero volts is applied. Furthermore, reference 1 also does not teach a switchable termination resistor, disposed on the substrate, having an impedance capable of providing a termination for an external circuit coupled to the substrate.

Reference 2: WO 00/67452

Reference 2 appears to be related to a telephony adapter device connected to a public telephone network, a conventional telephone, and a computer, which allows the conventional telephone to be used for both traditional telephony and computer network telephony. The

adapter device includes a first connector connected to the telephone, a second connector connected to the public telephone network, and a third connector connected to the computer. The adapter device includes a signal processing circuitry electrically connected to the third connector. The adapter includes a separate switch connected to the first and second connectors and the signal processing circuitry. The switch electrically connects the first connector to the second connector in a first position. The switch electrically connects the first connector to the signal processing circuitry in a second position.(Abstract)

However, reference 2 does not teach or suggest a communications device as recited in Applicants' claims. Considering claim 1, for example, Reference 2 does not teach or suggest a relay that is disposed on a substrate, and capable of being closed when zero volts is applied.

Reference 3: Hafer, R., "Designing Telephone-Interface Circuitry With Solid-State Relays," *Electronic Design*, 38:91-93 and 95-96, Penton Publishing, (December 1990).

Reference 3 appears to be related to solid state relays ("SSR") used in telephone interface circuitry. Reference 3 explores various properties, applications, and design consideration for SSRs. For example, SSRs avoid contact bounce problems, arcing, acoustic noise, and electromagnetic interference, which are all problems with mechanical switches.(Reference 3, page 91, col. 1) However, SSR designs require overvoltage protection to protect them from potential lighting damage, and are susceptible to overcurrent stresses. (Reference 3, page 91, col. 1)

However, Reference 3 does not teach or suggest a communications device as recited in Applicants' claims. Considering claim 1, for example, Reference 3 does not teach or

suggest a relay that is disposed on a substrate, and capable of being closed when zero volts is applied. Furthermore, Reference 3 also does not teach a switchable termination resistor, disposed on the substrate, having an impedance capable of providing a termination for an external circuit coupled to the substrate.

Reference 4: Foo, S., *et al.*, "A Telephone Adapter For Internet Telephone Systems," *Microprocessors and Microsystems*, 21:213-221, IPC Business Press Ltd., (December 1997)

Reference 4 appears to be related to an Internet telephone adapter ("ITA") device that is able to provide an interface between a conventional telephone and a host computer in order to enable Internet Telephony. The ITA enables users to dial an Internet telephone number to make a connection, be notified of an incoming call through ringing the telephone set, and carrying out the conversation using a conventional telephone handset. (Abstract)

However, Reference 4 does not teach or suggest a communications device as recited in Applicants' claims. Considering claim 1, for example, Reference 4 does not teach or suggest a relay that is disposed on a substrate, and capable of being closed when zero volts is applied. Furthermore, Reference 4 also does not teach a switchable termination resistor, disposed on a substrate, having an impedance capable of providing a termination for an external circuit coupled to the substrate.

V. Petition Fee

In accordance with the requirements of 37 C.F.R. § 1.102(d), Applicants submit herewith the Petition Fee of \$130.00 as required by 37 C.F.R. § 1.17. A check in that amount is enclosed.

The U.S. Patent and Trademark Office is hereby authorized to charge any fee deficiency, or credit any overpayment, to our Deposit Account No. 19-0036.


VI. Conclusion

Applicants respectfully submit that the requirements of 37 C.F.R. § 1.102 and M.P.E.P. § 708.02 pertaining to special status have been satisfied. Accordingly, it is respectfully requested that this Petition be granted.

This statement should not be construed as a representation that more material information, than that presented herein, does not exist. Furthermore, the submission of this material is not intended to displace the Examiner's professional ability and duty to search. Indeed, the Examiner is specifically requested not to rely solely on the materials submitted herewith. The Examiner is requested to conduct an independent and thorough review of the documents, and to form independent opinions as to their significance.

Respectfully submitted,

STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C.


Jeffrey T. Helvey
Attorney for Applicants
Registration No. 44,757

Date: 9/13/02

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*Admitted only in Maryland
*Admitted only in Virginia
*Admitted only in Texas
*Practice Limited to
Federal Agencies

September 13, 2002

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Commissioner for Patents
Washington, D.C. 20231

Re: U.S. Design Patent Application
Appl. No. 10/028,781; Filed: December 28, 2001
Inventor(s): FALLAHI et al.
For: IP Telephone System
Our Ref: 1875.1270001

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Sir:

Submitted herewith for appropriate action by the U.S. Patent and Trademark Office are the following documents:

1. Fee Transmittal Form (PTO/SB/17);
2. Petition to Make Special under 37 C.F.R. § 1.102(d);
3. FIVE (5) Documents;
4. Our Check No. 36654 for \$130.00 to cover the Petition to Make Special fee; and
5. One (1) Return postcard.

It is respectfully requested that the attached postcard be stamped with the date of filing of these documents, and that the postcard be returned to our courier.

The U.S. Patent and Trademark Office is hereby authorized to charge any fee deficiency, or credit any overpayment to our Deposit Account No. 19-0036. If extensions of time under 37 C.F.R.

Commissioner for Patents
September 13, 2002
Page 2

§ 1.136 are required to prevent abandonment of the present patent application, then such extensions of time are hereby petitioned, and any fees therefore are hereby authorized to be charged to our Deposit Account No. 19-0036.

Respectfully submitted,

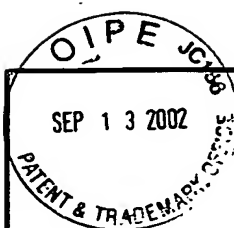
STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C.

A handwritten signature in black ink, appearing to read "J. Helvey", with a long, sweeping horizontal stroke extending to the right.

Jeffrey T. Helvey
Attorney for Applicant
Registration No. 44,757

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SKGF Rev. 2/15/02 dcw

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FEE TRANSMITTAL for FY 2002

Patent fees are subject to annual revision.

TOTAL AMOUNT OF PAYMENT

\$130.00

Complete if Known

Application Number	10/028,781
Filing Date	December 28, 2001
First Named Inventor	FALLAHI et al.
Examiner Name	To Be Assigned
Group Art Unit	2817
Attorney Docket No.	1875.1270001

METHOD OF PAYMENT (check one)

1. ☐ The Commissioner is hereby authorized to charge indicated fees and credit any overpayment to:

Deposit Account Number

19-0036

Deposit Account Name

Sterne, Kessler, Goldstein & Fox P.L.L.C.

- ☒ Charge Any Additional Fee Required Under 37 CFR §§ 1.16 and 1.17

- ☐ Applicant claims small entity status See 37 CFR 1.27

2. ☒ Payment Enclosed:

- ☒ Check ☐ Credit card ☐ Money Order ☒ Other*

*Charge any deficiencies or credit any overpayments in the fees or fee calculations of Parts 1, 2 and 3 below to Deposit Account No. 19-0036.

FEE CALCULATION

1. BASIC FILING FEE

Large Fee Code	Entity Fee (\$)	Small Fee Code	Entity Fee (\$)	Fee Description	Fee Paid
101	740	201	370	Utility filing fee	
106	330	206	165	Design filing fee	
107	510	207	255	Plant filing fee	
108	740	208	370	Reissue filing fee	
114	160	214	80	Provisional filing fee	

SUBTOTAL (1) (\$)

2. EXTRA CLAIM FEES

Extra	Fee from below	Fee Paid
Total Claims 33 - 20** =	X	=
Indep. Claims 5 - 3** =	X	=
Multiple Dependent		=

Large Fee Code	Entity Fee (\$)	Small Fee Code	Entity Fee (\$)	Fee Description
103	18	203	9	Claims in excess of 20
102	84	202	42	Independent claims in excess of 3
104	280	204	140	Multiple dependent claim
108	84	209	42	**Reissue independent claims over original patent
110	18	210	9	**Reissue claims in excess of 20 and over original patent

SUBTOTAL (2) (\$)

** or number previously paid, if greater; For Reissues, see above

FEE CALCULATION (continued)

3. ADDITIONAL FEES

Large Entity Small Entity

Fee Code	Fee (\$)	Fee Code	Fee (\$)	Fee Description	Fee paid
105	130	205	65	Surcharge - late filing fee or oath	
127	50	227	25	Surcharge - late provisional filing fee or cover sheet	
139	130	139	130	Non-English specification	
147	2,520	147	2,520	For filing a request for <i>ex parte</i> reexamination	
112	920*	112	920*	Requesting publication of SIR prior to Examiner action	
113	1,840*	113	1,840*	Requesting publication of SIR after Examiner action	
115	110	215	55	Extension for reply within first month	
116	400	216	200	Extension for reply within second month	
117	920	217	460	Extension for reply within third month	
118	1,440	218	720	Extension for reply within fourth month	
128	1,960	228	980	Extension for reply within fifth month	
119	320	219	160	Notice of Appeal	
120	320	220	160	Filing a brief in support of an appeal	
121	280	221	140	Request for oral hearing	
138	1,510	138	1,510	Petition to institute a public use proceeding	
140	110	240	55	Petition to revive - unavoidable	
141	1,280	241	640	Petition to revive - unintentional	
142	1,280	242	640	Utility issue fee (or reissue)	
143	460	243	230	Design issue fee	
144	620	244	310	Plant issue fee	
122	130	122	130	Petitions to the Commissioner	\$130.00
123	130	123	130	Petitions related to provisional applications	
126	180	126	180	Submission of Information Disclosure Stmt	
581	40	481	40	Recording each patent assignment per property (times number of properties)	
146	740	246	370	Filing a submission after final rejection (37 CFR 1.129(a))	
149	740	249	370	For each additional invention to be examined (37 CFR 1.129(b))	
179	740	279	370	Request for Continued Examination (RCE)	
169	900	169	900	Request for expedited examination of a design application	

Other fee (specify):

Other fee (specify):

*Reduced by Basic Filing Fee Paid

SUBTOTAL (3) (\$) 130.00

SUBMITTED BY

Complete (if applicable)

Name (Print/Type)	Jeffrey T. Helvey	Registration No. (Attorney/Agent)	44,757	Telephone	202-371-2600
Signature		Date	9/13/02		

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